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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,290	03/09/2001	Shimon Shmueli	4989-008	7144
27820	7590	06/16/2004	EXAMINER	
WITHROW & TERRANOVA, P.L.L.C. P.O. BOX 1287 CARY, NC 27512			KLIMACH, PAULA W	
		ART UNIT	PAPER NUMBER	
		2135	7	
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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/803,290	SHMUEL ET AL.
	Examiner Paula W Klimach	Art Unit 2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 09 March 2001.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-32 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-32 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 2-6.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Double Patenting***

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 1 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of copending Application No. 09803291. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim 8 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 11 of copending Application No. 09803291. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim 19 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 17 of copending Application No. 09803291. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claim 14** rejected under 35 U.S.C. 102(e) as being anticipated by Guthery (6,567,915).

Guthery discloses a portable device comprising: a body (Fig. 1 part 24); memory within the body containing software for executing or a host-computing device (Fig. 2 part 64); an interface associated with the memory and adapted to facilitate interaction with the host computing device (column 4 lines 46-50); the software adapted to automatically execute on the host computing device in association with a computing session and store select information associated with the computing session in the memory instead of on the host computing device, wherein the host computing device would normally store the select information on the host computing device when the portable device is not present (column 5 lines 1-58).

***Claim Rejections - 35 USC § 103***

3. **Claims 1-13 and 15-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over de la Huerga (5,960,085) in view of Guthery (6,567,915).

The device disclosed De la Huerga uses a portable device for access control to a network (column 9 lines 20-50). The access control of the above mentioned system provides automatic logon and log off (column 6 lines 31-40) therefore the software executes automatically on the host-computer device when the portable device is detected and therefore a session starts. The system disclosed by de la Huerga also deletes files after the user has logged off. Logging off is a sign that the session is over (column 5 lines 11-25).

However de la Huerga does not expressly disclose a system wherein in the portable device comprises a body, memory containing software and an interface associated with the memory.

Guthery discloses a portable device comprising: a body (Fig. 1 part 24); memory within the body containing software for executing on a host computing device (Fig. 2 part 64); an interface associated with the memory and adapted to facilitate interaction with the host computing device (column 4 lines 46-50).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have a portable device with a body, memory, and an interface associated with the memory as in the system of Guthery in the portable device of de la Huerga. One of ordinary skill in the art would have been motivated to do this because this would free memory that was in the system for storage of other information and allow the user use any terminal.

*In reference to claims 2, 17, 20, and 28, wherein the software is further adapted to instruct the host-computing device to detect instructions from the user indicating the termination of the computing session.* de la Huerga discloses a system wherein when the user walks away from the system, thereby ending a computing session, the host system detects the absence of a signal and indicating the presence of the user and therefore log the user off (column 5 lines 1-10).

*In reference to claims 3, 18, 21, and 29, wherein the software is further adapted to instruct the host-computing device to detect disassociation of the portable device from the host-computing device to indicate termination of the computing session.* de la Huerga discloses a system wherein a signal is sent from the security badge (portable device) to the host device

(column 4 lines 65-67). When the signal is obstructed, the computer terminal determines that the session is over and logs the user off (column 5 lines 1-10).

*In reference to claims 4 and 22, wherein the software is adapted to instruct the host computing device to delete one or more of the group consisting of browsing histories, cookie preferences, favorites, and bookmarks from one or more of the group consisting of system memory, cache, and disk drives. de la Huerga discloses a system wherein the browser cache containing the record the URLs accessed through the browser program, which correspond to browsing histories and cookies (column 5 lines 15-20).*

*In reference to claims 5 and 23, wherein the software is further adapted to instruct the host computing device to automatically execute on the host computing device after the host computing device recognizes the presence of the portable device and instruct the host computing device to launch a program on the host computing device. de la Huerga discloses a system that provides a self-authenticating identification badge that remains in frequent communication with the network (column 6 lines 41-48).*

*In reference to claims 6 and 24, wherein the software is further adapted to instruct the host-computing device to customize the user interface for the program for the computing session based on the data. de la Huerga discloses a system that gives the host information about the user and therefore about the user's privileges (session data); thereby customizing the user interface for the program for the computing session based on the user data (column 13 lines 36-46).*

*In reference to claims 7, 25, and 30, wherein the software is further adapted to provide an authentication routine to execute on the host-computing device, the authentication routine including receiving authentication indicia from a user via an interface on the host computing*

device and determining if the authentication indicia received from the user matches authentication indicia stored in the memory (column 13 lines 47-65).

*In reference to claims 8 and 26, wherein the software is further adapted to provide an authentication routine to execute on the host-computing device, the authentication routine including receiving authentication indicia from the user via an interface on the host and determining if the authentication indicia received from the user matches authentication indicia stored in the memory (column 13 lines 47-65).*

*In reference to claim 9, wherein the software is adapted to emulate a file system resident on a memory device on the host computing device when interacting with the host computing device (column 21 lines 30-55). The system of de la Huerga displays the data records in HTML on the terminal. The security badge transmits the records to the terminal.*

*In reference to claim 10 wherein the software and data are adapted to appear as a file system to the host-computing device (column 21 lines 30-55).*

*In reference to claim 12, wherein the interface is adapted to provide a wireless interface with the host-computing device (column 9 lines 20-31).*

*In reference to claim 11 wherein the interface is adapted to directly interface a port in the host-computing device.*

de la Huerga does not expressly disclose the interface adapted to directly interface a port in the host-computing device.

Guthery discloses a system wherein the interface is adapted to directly interface with a port in the host-computer device (column 6 lines 55-60).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to interface with the port of the terminal as in the system of Guthery in the portable device of de la Huerga. One of ordinary skill in the art would have been motivated to do this because ports are interfaces between computers and other devices and therefore can be used to send data to and from the computer and the device.

*In reference to claims 13 and 31, wherein the software includes a plurality of keylets that are independently executable on the host-computing device to provide at least one function.*

de la Huerga does not expressly disclose the software includes a plurality of keylets that are independently executable on the host-computing device to provide at least one function.

Guthery teaches programs stored on the portable device that are similar to the keylets. The point of transaction has a corresponding program and therefore runs the programs (64) on the terminal (column 6 lines 40-43).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use the programs as in the system of Guthery in the portable device of de la Huerga. One of ordinary skill in the art would have been motivated to do this because it would simplify the coordination between the device and the terminal.

*In reference to claim 15, wherein the software is further adapted to instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session (column 5 lines 11-25).*

*In reference to claim 16, wherein the software is further adapted to instruct the host computing device to remove the records pertaining to the computing session from the host*

computing device, in association with termination of the computing session (column 5 lines 11-25).

*In reference to claim 32, the method further comprising: executing the software on a host computing device (column 21 lines 30-54); launching a program resident on the host computing device based on the software (column 21 lines 45-50); accessing configuration information for the software stored on the portable memory device; and customizing the configuration for the program on the host computing device based on the configuration information (column 13 lines 36-46).*

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula W Klimach whose telephone number is (703) 305-8421. The examiner can normally be reached on Mon to Thr 9:30 a.m to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (703) 305-4393. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Paula W Klimach  
Art 2135*

PWK  
Tuesday, June 08, 2004

In the Claims:

1. (Currently Amended) A portable device comprising:

- a) a body;
- b) memory within the body containing software for loading into read/write memory of a host computing device and executing on [[a]] the host computing device, said software comprising a computer program; and
- c) an interface associated with the memory and adapted to facilitate interaction with the host computing device;
- d) the software adapted to automatically execute on the host computing device in association with a computing session and provide an interface frame associated with the portable device on a display of the host computing device, and further adapted to, in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session.

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2. (Original) The portable device of claim 1 wherein said software is further adapted to instruct the host computing device to display an icon on the interface frame corresponding to a function provided by the software such that upon selection of the icon, the software will execute the function on the host computing device.

3. (Original) The portable device of claim 1 wherein said software is further adapted to instruct the host computing device to display a menu icon on the interface frame corresponding to a menu of function icons such that upon selection of the menu icon the software will execute on the host computing device to display the menu of function icons and upon selection of one of the function icons, the software will execute a corresponding function on the host computing device.

4. (Original) The portable device of claim 3 wherein the function icons are only displayed on the menu of function icons and nowhere else on the interface frame.

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5. (Original) The portable device of claim 1 wherein the software is further adapted to instruct the host computing device to display indicia providing a link to a web site on the interface frame.

6. (Original) The portable device of claim 1 wherein the software is further adapted to instruct the host computing device to display indicia providing a link to a web site associated with the provider of the portable device on the interface frame.

7. (Original) The portable device of claim 1 wherein the software is further adapted to instruct the host computing device to automatically access web content from a predefined web site and display the web content in the interface frame upon displaying the interface frame.

8. (Original) The portable device of claim 1 wherein the software is further adapted to instruct the host computing device to display predefined content in relation to content displayed by the web browser such that the predefined content overlays information provided by the web browser, the predefined content controlled by the portable device.

9. (Original) The portable device of claim 1 wherein the interface frame is a banner including markup language content defined by at least one of the group consisting of information stored on the portable device or web content from a link stored on the portable device.

10. (Canceled).

11. (Original) The portable device of claim 1 wherein the software is further adapted to provide an authentication routine to execute on the host computing device, the authentication routine including receiving authentication indicia from the user via an interface on the host computing device and determining if the authentication indicia received from the user matches authentication indicia stored in the memory.

12. (Original) The portable device of claim 1 wherein the software is further adapted to cooperate with a defined web service to push web content to the host computing device and display the web content in the interface frame.
13. (Original) The portable device of claim 1 wherein the software is adapted to emulate a file system resident on a memory of the host computing device when interacting with the host computing device.
14. (Original) The portable device of claim 1 wherein the software and data are adapted to appear as a file system to the host computing device.
15. (Original) The portable device of claim 1 wherein the interface is adapted to directly interface a port in the host computing device.
16. (Original) The portable device of claim 1 wherein the interface is adapted to provide a wireless interface with the host computing device.
17. (Currently Amended) A computer readable medium including software to reside on a portable device capable of interacting with a plurality of host computing devices, the software comprising a computer program adapted to be held in the memory associated with the portable device and further adapted to be loaded into read/write memory of a host computing device for execution, said software comprising instructions to:
  - a) automatically execute on [[a]] the host computing device in association with a computing session; [and]
  - b) provide an interface frame associated with the portable device on a display of the host computing device; and
  - c) in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session.

4.  
PAGE 5/16 \* RCVD AT 4/7/2004 3:50:06 PM (Eastern Daylight Time) \* SVR:USPTO-EFXRF-1/1 \* DNIS:8729306 \* CSID:919 654 4521 \* DURATION (mm:ss):04:54

18. (Currently Amended) The computer readable memory medium of claim 17 wherein said software is further adapted to display an icon on the interface frame corresponding to a function provided by the software such that upon selection of the icon, the software will execute the function on the host computing device.

19. (Currently Amended) The computer readable memory medium of claim 17 wherein said software is further adapted to display a menu icon on the interface frame corresponding to a menu of function icons such that upon selection of the menu icon the software will execute on the host computing device to display the menu of function icons and upon selection of one of the function icons, the software will execute a corresponding function on the host computing device.

20. (Currently Amended) The computer readable memory medium of claim 19 wherein the function icons are only displayed on the menu of function icons and nowhere else on the interface frame.

21. (Currently Amended) The computer readable memory medium of claim 17 wherein the software is further adapted to display indicia providing a link to a web site on the interface frame.

22. (Currently Amended) The computer readable memory medium of claim 17 wherein the software is further adapted to display indicia providing a link to a web site associated with the provider of the portable device on the interface frame.

23. (Currently Amended) The computer readable memory medium of claim 17 wherein the software is further adapted to automatically access web content from a predefined web site and display the web content in the interface frame upon displaying the interface frame.

24. (Currently Amended) The computer readable memory medium of claim 17 wherein the software is further adapted to display predefined content in relation to content displayed

by the web browser such that the predefined content overlays information provided by the web browser, the predefined content controlled by the portable device.

25. (Currently Amended) The computer readable memory medium of claim 17 wherein the interface frame is a banner including markup language content defined by at least one of the group consisting of information stored on the portable device or web content from a link stored on the portable device.
26. (Canceled).
27. (Currently Amended) The computer readable memory medium of claim 17 wherein the software is further adapted to provide an authentication routine to execute on the host computing device, the authentication routine including receiving authentication indicia from the user via an interface on the host computing device and determining if the authentication indicia received from the user matches authentication indicia stored in the memory.
28. (Currently Amended) The computer readable memory medium of claim 17 wherein the software is further adapted to cooperate with a defined web service to push web content to the host computing device and display the web content in the interface frame.
29. (Currently Amended) A method for implementing functions provided by software residing on a portable device on a plurality of host computing devices, wherein the software comprises a computer program held in memory associated with the portable device and adapted to be loaded into read/write memory of one of the host computing devices for execution, the method comprising:
  - a) automatically executing the software on a host computing device in association with a computing session; [[and]]
  - b) providing an interface frame associated with the portable device on a display of the host computing device based on executing the software; and

c) in association with termination of the computing session, instructing the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session.

30. (Original) The method of claim 29 further comprising displaying an icon on the interface frame corresponding to a function provided by the software, and upon selection of the icon, executing the function on the host computing device.

31. (Original) The method of claim 29 further comprising:  
a) displaying a menu icon on the interface frame corresponding to a menu of function icons;  
b) upon selection of the menu icon, displaying the menu of function icons; and  
c) upon selection of one of the function icons, executing a corresponding function on the host computing device.

32. (Original) The method of claim 31 wherein the function icons are only displayed on the menu of function icons and nowhere else on the interface frame.

33. (Original) The method of claim 29 further comprising displaying indicia providing a link to a web site on the interface frame.

34. (Original) The method of claim 29 further comprising displaying indicia providing a link to a web site associated with the provider of the portable device on the interface frame.

35. (Original) The method of claim 29 further comprising automatically accessing web content from a predefined web site and displaying the web content in the interface frame upon displaying the interface frame.

36. (Original) The method of claim 29 further comprising displaying predefined content in relation to content displayed by the web browser such that the predefined content

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overlays information provided by the web browser, the predefined content controlled by the portable device.

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37. (Original) The method of claim 29 wherein the interface frame is a banner including markup language content defined by at least one of the group consisting of information stored on the portable device or web content from a link stored on the portable device.
38. (Canceled).
39. (Original) The method of claim 29 further comprising:
  - a) executing an authentication routine provided by the portable device on the host computing device;
  - b) receiving authentication indicia from the user via an interface on the host computing device; and
  - c) determining if the authentication indicia received from the user matches authentication indicia stored in the memory.
40. (Previously Presented) The method of claim 29 further comprising:
  - a) cooperating with a defined web service to push web content to the host computing device, and
  - b) displaying the web content in the interface frame.

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